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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/004,379	11/01/2001	James G. Donaghy	18494.078	7261

7590

11/10/2003

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EXAMINER

PARKER, FREDERICK JOHN

ART UNIT	PAPER NUMBER
1762	

5

DATE MAILED: 11/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/004,379	Applicant(s) DONAGHY, JAMES G.	
	Examiner Frederick J. Parker	Art Unit 1762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☒ Claim(s) 10 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>11/1/01</u> . | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: [0007], it is unclear how a latex elastomer may be applied in gaseous form as the Examiner is unaware of any elastomer present as a gas. Appropriate correction is required.

Claim Objections

2. Claim 10 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim must refer back in the alternative. See MPEP § 608.01(n). Accordingly, the claim not been further treated on the merits. The wording states the fabric produced according to more than one of the foregoing claims. See 601.01n/B.1.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 5 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification is not enabled for application of an elastomeric composition in gaseous form to a textile fabric.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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6. Claims 5,9,10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claim 5 is vague and indefinite because it is unclear how an elastomeric composition can be “vaporous or gaseous”, and accordingly applied to a textile fabric.
- Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite in that it fails to point out what is included or excluded by the claim language. This claim is an omnibus type claim.
- Claim 10 is vague and indefinite because it is unclear how the intended article can be ascertained because (1) claim 9 does not set forth a specific method of making, and (2) it is unclear how the fabric can be produced by a plurality of the “foregoing claims” since the claims need not be related to one-another.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1,3,5,6,8 are rejected under 35 U.S.C. 102(b) as being anticipated by Campbell, Sr et al US 3854978.

Campbell, Sr et al teaches a method for altering/ enhancing elasticity of a permeable textile fabric, including apparel fabric (per claim 8), by selectively applying a liquid silicone

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elastomeric material to portions of the fabric (fig. 1; col. 1, 36-57; col. 2, 28-32), per claim 1. The elastomeric material may be selectively applied by nozzles or needles 20 which are inherently selectively controllable ejection nozzle means per claim 3. Nozzles also inherently cause atomization of coating liquid (same as vaporous/ airborne atomized as defined in [0002]). Penetration/ seepage of the liquid elastomer into the fabric is disclosed on col. 2, 57-61, per claim 6.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Campbell Sr et al.

Campbell Sr et al is cited for the same reasons previously discussed, which are incorporated herein. While an elastic textile fabric is not cited, nor are the textile fabrics of the reference limited. It also would have been obvious to use the process on elastic textile fabrics to enhance

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Elasticity which is the benefit provided by the method. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the elastomeric patterns of Campbell Sr et al to an elastic fabric because of the expectation of successfully applying such patterns to enhance the elasticity/ flexibility of the fabric.

12. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Campbell Sr et al in view of Bachtiger US 4148604.

Campbell Sr et al is cited for the same reasons previously discussed, which are incorporated herein. Applying the elastomeric designs by a mask, stencil, or print screen is not taught.

Bachtiger teaches to apply liquid polymers/ plastic material to textile surfaces using a screen printing means which applies the coating material through openings in the stencil screen onto and into the fabric (col. 1, 5-12; col. 2, 16-37; col. 5, 37 to col. 6, 12). Since Bachtiger teaches screen printing stenciled designs onto textile fabric surfaces, and Campbell Sr et al applies elastomeric polymers in designs onto/into textile fabrics to enhance elasticity, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Campbell, Sr et al by substituting the screen printing means of Bachtiger for the nozzle means of Campbell Sr et al because of the expectation of successfully applying selective designs of liquid elastomeric material to the fabric to enhance the elasticity/ flexibility of the fabric.

13. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Campbell Sr et al in view of Fottinger et al.

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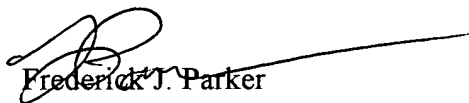
Campbell Sr et al is cited for the same reasons previously discussed, which are incorporated herein. Applying the composition as an aqueous-based elastomeric composition is not taught.

Fottinger et al teaches applying an aqueous-based elastomeric impregnating solution to fabric, the elastomer being used as a bonding agent because of its elastic resiliency (col. 4, 3-28) to provide softness to the fabric which forms a fabric-type artificial leather. While Campbell, Sr et al does not require the product to be such an artificial leather, both references apply elastomeric compositions to enhance softness/ elasticity of textile fabrics, and hence the use of an aqueous-based elastomeric material taught by Fottinger et al in the proves of Campbell Sr et al would have been obvious to one of ordinary skill in the art at the time the invention was made because of the expectation of enhancing the elasticity/ flexibility/ softness of the fabric.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frederick J. Parker whose telephone number is 703/308-3474. The examiner can normally be reached on Mon-Thur. 6:15am -3:45pm, and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive Beck can be reached on 703/308-2333. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703/308-0661.


Frederick J. Parker
Primary Examiner
Art Unit 1762

fjp